UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,591	06/19/2001	Kei Yamada	01365/LH	2582

1933 7590 03/18/2005	EXAMINER
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC	POKRZYWA, JOSEPH R
767 THIRD AVENUE	

ART UNIT	PAPER NUMBER
2622	

25TH FLOOR
NEW YORK, NY 10017-2023

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/884,591	YAMADA ET AL.
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

    4a) Of the above claim(s) *24-40* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1.   Restriction to one of the following inventions is required under 35 U.S.C. 121:

    I.   **Claims 1-23**, drawn to a system that obtains a rewrite program at an image

forming apparatus stored in an administering apparatus through a network, and

rewrites the program stored in the image forming apparatus with the rewrite

program, classified in class 358, subclass 1.15.

    II.   **Claims 24-40**, drawn to a system that accesses mail servers with a predetermined

access interval in order to transmit or receive electronic mail, classified in class

709, subclass 212.

The inventions are distinct, each from the other because of the following reasons:

2.   Inventions I and II are related as subcombinations disclosed as usable together in a single

combination. The subcombinations are distinct from each other if they are shown to be

separately usable. In the instant case, invention I has separate utility such as a system that

downloads program updates, while invention II has separate utility such as a system that accesses

electronic mail stored on a server at predetermined intervals. See MPEP § 806.05(d).

3.   Because these inventions are distinct for the reasons given above and the search required

for Group I is not required for Group II, restriction for examination purposes as indicated is

proper.

4.   During a telephone conversation with Leonard Holtz on Monday, March 14, 2005, a

provisional election was made with traverse to prosecute the invention of Group I, claims 1-23.

Affirmation of this election must be made by applicant in replying to this Office action. Claims

24-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being

drawn to a non-elected invention.

5.   Applicant is reminded that upon the cancellation of claims to a non-elected invention, the

inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR

1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

6.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers

have been placed of record in the file.

Information Disclosure Statement

7.   The cited publications noted in the Information Disclosure Statement submitted on 3/9/05

have been considered by the examiner. However, the examiner notes that Form PTO/SB/08A

was not found within the file. The examiner requests that a new form be submitted listing the

references so that the examiner can return an initialed copy.

Drawings

8.   The drawings received on 6/19/01 are acceptable by the examiner.

Claim Objections

9.   **Claims 4 and 12** are objected to because of the following informalities:

In *claims 4 and 12*, line 3 of both claims, "leas" should read "least".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11.   **Claims 1-6, 9-20, 22, and 23** are rejected under 35 U.S.C. 102(b) as being anticipated by

Domenikos *et al.* (U.S. Patent Number 5,838,916).

Regarding *claim 1*, Domenikos discloses an image forming system comprising an image

forming apparatus (client 12, see Figs. 1-5) to form an image on a recording material (column 1,

lines 51-61, column 5, lines 64-column 6, line 12, and column 19, lines 7-36) and comprising a

first memory section to store a program to conduct a predetermined operation (cache memory

216, column 3, lines 51-67, and column 17, lines 13-65), and an image forming apparatus

connecting section to connect the image forming apparatus with a network (see Figs. 3-5, and

column 10, line 65-column 11, line 18), and an administrating apparatus (server 14, see Figs. 1-

5) to administrate the image forming apparatus through the network and comprising an

administering memory section to store a rewrite program for the image forming apparatus (see

Figs. 3-5, disk 46, column 11, line 43-column 12, line 33), and an administrating apparatus

connecting section to connect the administrating apparatus with the network (see Figs. 3-5, and

column 11, lines 1-31), wherein the image forming apparatus accesses the administrating

apparatus through the network, obtains the rewrite program stored in the administrating memory

section and rewrites the program stored in the first memory section with the obtained rewrite

program (column 3, lines 51-67, and column 17, line 44-column 19, line 34).

Regarding *claim 2*, Domenikos discloses the system discussed above in claim 1, and

further teaches that the network is a internet (column 10, line 65-column 11, line 31).

Regarding *claim 3*, Domenikos discloses the system discussed above in claim 1, and

further teaches that after judging whether the rewrite program stored in the administrating

memory section is a rewrite program for rewriting the program stored in the first memory

section, the image forming apparatus obtains the rewrite program (column 17, lines 30-65), or

after obtaining the rewrite program from the administrating memory section, the image forming

apparatus judges whether the obtained rewrite program is a rewrite program for rewriting the

program stored in the first memory section and then rewrites the program stored in the first

memory section (column 17, lines 30-65).

Regarding *claim 4*, Domenikos discloses the system discussed above in claim 3, and

further teaches that the program and the rewrite program are correlated respectively with at least

one of producing date information, storing date information, version information, history

information, and type information of the image forming apparatus and whether the rewrite

program is a rewrite program for rewriting the program stored in the first memory is judged

based on the correlated information (column 17, line 12-column 18, line 34).

Regarding *claim 5*, Domenikos discloses the system discussed above in claim 1, and

further teaches that the administrating memory section stores a plurality of rewrite programs

(column 8, line 40-column 9, line 34, and column 9, line 61-column 10, line 29, and column 12,

lines 5-50).

Regarding *claim 6*, Domenikos discloses the system discussed above in claim 1, and

further teaches that the image forming apparatus downloads the rewrite program in accordance

with a download instruction transmitted from the administrating apparatus (column 14, lines 10-

49)..

Regarding *claim 9*, Domenikos discloses the system discussed above in claim 1, and

further teaches that the image forming apparatus is provided in a local user network on which a

sub-host section having a second memory section to store the rewrite program is provided

(column 9, line 4-column 10, line 38, and column 11, line 53-column 12, line 33), and wherein

the image forming apparatus obtains the rewrite program through the sub-host section and

rewrites the program stored in the first memory (column 17, line 30-column 18, line 46).

Regarding *claim 10*, Domenikos discloses the system discussed above in claim 9, and

further teaches that the sub-host section judges whether the rewrite program stored in the

administrating memory section is a rewrite program for rewriting the program stored in the first

memory section and obtains the rewrite program based on the judgment (column 17, lines 30-

65).

Regarding *claim 11*, Domenikos discloses the system discussed above in claim 9, and further teaches that after judging whether the rewrite program stored in the second memory section is a rewrite program for rewriting the program stored in the first memory section, the image forming apparatus obtains the rewrite program (column 17, lines 30-65), or after obtaining the rewrite program from the second memory section, the image forming apparatus judges whether the obtained rewrite program is a rewrite program for rewriting the program stored in the first memory section and then rewrites the program stored in the first memory section (column 17, lines 30-65).

Regarding *claim 12*, Domenikos discloses the system discussed above in claim 9, and further teaches that the program and the rewrite program are correlated respectively with at least one of producing date information, storing date information, version information, history information, and type information of the image forming apparatus and whether the rewrite program is a rewrite program for rewriting the program stored in the first memory is judged based on the correlated information (column 17, line 12-column 18, line 34).

Regarding *claim 13*, Domenikos discloses the system discussed above in claim 9, and further teaches that the sub-host section obtains a rewrite program for a plurality of image forming apparatus connected to the user network from the administrating section and administrates rewriting a program of the plurality of image forming apparatus (column 17, line 30-column 18, line 34).

Regarding *claim 14*, Domenikos discloses the system discussed above in claim 9, and further teaches that the image forming apparatus obtains the rewrite program stored in the second memory in accordance with a download instruction transmitted from the sub-host section and

rewrites the program stored in the first memory with the rewrite memory (column 17, line 12-

column 18, line 34).

Regarding *claim 15*, Domenikos discloses the system discussed above in claim 9, and

further teaches that the sub-host section accesses the administrating apparatus in accordance with

a download instruction transmitted from the administrating apparatus (column 17, line 12-

column 18, line 34).

Regarding *claim 16*, Domenikos discloses the system discussed above in claim 1, and

further teaches that the image forming apparatus is prohibited to rewrite the program stored in

the first memory during an image formation (column 17, line 66-column 18, line 34).

Regarding *claim 17*, Domenikos discloses the system discussed above in claim 16, and

further teaches that the image forming apparatus is prohibited to obtain the rewrite program

during an image formation (column 17, line 66-column 18, line 34).

Regarding *claim 18*, Domenikos discloses an image forming apparatus (client 12, see

Figs. 1-5) to form an image on a recording material (column 1, lines 51-61, column 5, lines 64-

column 6, line 12, and column 19, lines 7-36) comprising a first memory section to store a

program to conduct a predetermined operation (cache memory 216, column 3, lines 51-67, and

column 17, lines 13-65), and a first connecting section to connect the image forming apparatus

with the network (see Figs. 3-5, and column 10, line 65-column 11, line 18), wherein the image

forming apparatus accesses through a network an administrating apparatus provided on the

network and storing a rewrite program for the image forming apparatus, obtains the rewrite

program, and rewrites the program stored in the first memory section with the obtained rewrite

program (column 3, lines 51-67, and column 17, line 44-column 19, line 34).

Regarding *claim 19*, Domenikos discloses the apparatus discussed above in claim 18, and

further teaches that the network is a internet (column 10, line 65-column 11, line 31).

Regarding *claim 20*, Domenikos discloses the apparatus discussed above in claim 18, and

further teaches that after judging whether the rewrite program stored in the administrating

memory section is a rewrite program for rewriting the program stored in the first memory

section, the image forming apparatus obtains the rewrite program (column 17, lines 30-65), or

after obtaining the rewrite program from the administrating memory section, the image forming

apparatus judges whether the obtained rewrite program is a rewrite program for rewriting the

program stored in the first memory section and then rewrites the program stored in the first

memory section (column 17, lines 30-65).

Regarding *claim 22*, Domenikos discloses the apparatus discussed above in claim 18, and

further teaches that the image forming apparatus is prohibited to rewrite the program stored in

the first memory during an image formation (column 17, line 66-column 18, line 34).

Regarding *claim 23*, Domenikos discloses the apparatus discussed above in claim 22, and

further teaches that the image forming apparatus is prohibited to obtain the rewrite program

during an image formation (column 17, line 66-column 18, line 34).

12.   **Claims 1-4, 6-8, 18, 19, and 21** are rejected under 35 U.S.C. 102(b) as being anticipated

by Nachinson *et al.* (U.S. Patent Number 6,037,928).

Regarding *claim 1*, Nachinson discloses an image forming system comprising an image

forming apparatus to form an image on a recording material (column 5, lines 30-52, and column

9, lines 11-38) and comprising a first memory section to store a program to conduct a

predetermined operation (column 5, lines 53-58, column 8, lines 12-44, and column 10, lines 23-27), and an image forming apparatus connecting section to connect the image forming apparatus with a network (column 8, line 5-column 9, line 10), and an administrating apparatus to administrate the image forming apparatus through the network and comprising an administering memory section to store a rewrite program for the image forming apparatus (column 9, lines 17-38), and an administrating apparatus connecting section to connect the administrating apparatus with the network (column 9, line 11-column 10, line 32), wherein the image forming apparatus accesses the administrating apparatus through the network, obtains the rewrite program stored in the administrating memory section and rewrites the program stored in the first memory section with the obtained rewrite program (column 9, line 60-column 10, line 32).

Regarding *claim 2*, Nachinson discloses the system discussed above in claim 1, and further teaches that the network is a internet (column 8, line 5-column 9, line 10).

Regarding *claim 3*, Nachinson discloses the system discussed above in claim 1, and further teaches that after judging whether the rewrite program stored in the administrating memory section is a rewrite program for rewriting the program stored in the first memory section, the image forming apparatus obtains the rewrite program, or after obtaining the rewrite program from the administrating memory section, the image forming apparatus judges whether the obtained rewrite program is a rewrite program for rewriting the program stored in the first memory section and then rewrites the program stored in the first memory section (column 9, line 11-column 10, line 32).

Regarding *claim 4*, Nachinson discloses the system discussed above in claim 3, and further teaches that the program and the rewrite program are correlated respectively with at least

one of producing date information, storing date information, version information, history

information, and type information of the image forming apparatus and whether the rewrite

program is a rewrite program for rewriting the program stored in the first memory is judged

based on the correlated information (column 10, lines 23-32).

Regarding *claim 6*, Nachinson discloses the system discussed above in claim 1, and

further teaches that the image forming apparatus downloads the rewrite program in accordance

with a download instruction transmitted from the administrating apparatus (column 8, line 54-

column 10, line 32).

Regarding *claim 7*, Nachinson discloses the system discussed above in claim 6, and

further teaches that the download instruction is transmitted through another network different

from the network to transmit the rewrite program (column 10, lines 10-32).

Regarding *claim 8*, Nachinson discloses the system discussed above in claim 7, and

further teaches that the network to transmit the rewrite program is an internet and the network to

transmit the download instruction is a telephone line (column 2, lines 22-43, and column 8, line

12-column 9, line 10).

Regarding *claim 18*, Nachinson discloses an image forming apparatus to form an image

on a recording material (column 5, lines 30-52, and column 9, lines 11-38) comprising a first

memory section to store a program to conduct a predetermined operation (column 5, lines 53-58,

column 8, lines 12-44, and column 10, lines 23-27), and a first connecting section to connect the

image forming apparatus with the network (column 8, line 5-column 9, line 10), wherein the

image forming apparatus accesses through a network an administrating apparatus provided on

the network and storing a rewrite program for the image forming apparatus, obtains the rewrite

program, and rewrites the program stored in the first memory section with the obtained rewrite

program (column 9, line 60-column 10, line 32).

Regarding *claim 19*, Nachinson discloses the apparatus discussed above in claim 18, and

further teaches that the network is a internet (column 8, line 5-column 9, line 10).

Regarding *claim 21*, Nachinson discloses the apparatus discussed above in claim 18, and

further teaches that the network to transmit the rewrite program is an internet and the image

forming apparatus comprises a second communicating device to connect with a telephone line

(column 2, lines 22-43, and column 8, lines 12-32) and wherein the image forming apparatus

conduct obtaining the rewrite program in accordance with a download instruction transmitted

from the administrating apparatus through the telephone line (column 8, line 12-column 10, line

32).

Citation of Pertinent Prior Art

13.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure:

Ninomiya (U.S. Patent Number 6,543,008) discloses a program rewriting method for a
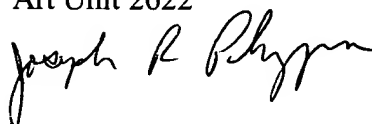
computer system.

Conclusion

14.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp